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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,950	06/23/2000	Pawel Rej	169.1753	8958
5514	7590	09/01/2006		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER SINGH, RACHNA	
			ART UNIT 2176	PAPER NUMBER

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/599,950	<b>Applicant(s)</b> REJ, PAWEL	
	<b>Examiner</b> Rachna Singh	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7, 9-15, 17-19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-15, 17-19, and 21-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: After-Final Arguments filed 08/11/06.
2. Claims 1-3, 5-7, 9-15, 17-19, and 21-26 are pending. Claims 1, 7, 13, 19, 25, and 26 are independent claims.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-3, 5-7, 9-15, 17-19, and 21-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claim 1 is drawn to non-statutory subject matter because it fails to produce a tangible result. In order to be statutory, the claim must produce a useful, concrete, and tangible result. Specifically, marking nodes with a common mark specific to a target area does not necessarily produce a tangible result unless the structure of the input tree is either saved, stored, or displayed. The mere marking of a data structure fails to produce a tangible result.

Claims 2-3 and 5-6 are rejected under 35 U.S.C. 101 for fully incorporating the deficiencies of their base claim.

6. Claim 7 is drawn to non-statutory subject matter because it fails to produce a tangible result. In order to be statutory, the claim must produce a useful, concrete, and tangible result. Specifically, generating the tree fragment from the nodes marked with a common mark does not produce a tangible result unless the tree fragment is saved, stored, or displayed. The mere generating of a data structure fails to produce a tangible result.

Claims 9-12 are rejected under 35 U.S.C. 101 for fully incorporating the deficiencies of their base claim.

7. Claim 13 is drawn to non-statutory subject matter because it fails to produce a tangible result. In order to be statutory, the claim must produce a useful, concrete, and tangible result. Specifically, marking nodes with a common mark specific to a target area does not necessarily produce a tangible result unless the structure of the input tree is either saved, stored, or displayed. The mere marking of a data structure fails to produce a tangible result.

Furthermore, claim 13 is considered software per se. Computer programs may be explicitly claimed as, for example, a series of code or instructions for performing functions or may be implicitly claimed as, for example, a system, a module or an

apparatus. Where there is no evidence in the specification that a means which may be interpreted as software, hardware or combinations thereof necessarily includes hardware, it will be interpreted in its broadest reasonable sense as a software means, which is the case here.

Thus a claim to functional descriptive material, including computer programs, per se, is not patent eligible subject matter. It should be noted that functional descriptive material claimed in combination with an appropriate computer readable medium to enable the functionality to be realized is patent eligible subject matter if it is capable of producing a useful, concrete and tangible result when used in the computer system.

Claims 14-15 and 17-18 are rejected under 35 U.S.C. 101 for fully incorporating the deficiencies of their base claim.

8. Claim 19 is drawn to non-statutory subject matter because it fails to produce a tangible result. In order to be statutory, the claim must produce a useful, concrete, and tangible result. Specifically, generating the tree fragment from the nodes marked with a common mark does not produce a tangible result unless the tree fragment is saved, stored, or displayed. The mere generating of a data structure fails to produce a tangible result.

Furthermore, claim 19 is considered software per se. Computer programs may be explicitly claimed as, for example, a series of code or instructions for performing functions or may be implicitly claimed as, for example, a system, a module or an

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apparatus. Where there is no evidence in the specification that a means which may be interpreted as software, hardware or combinations thereof necessarily includes hardware, it will be interpreted in its broadest reasonable sense as a software means, which is the case here.

Thus a claim to functional descriptive material, including computer programs, per se, is not patent eligible subject matter. It should be noted that functional descriptive material claimed in combination with an appropriate computer readable medium to enable the functionality to be realized is patent eligible subject matter if it is capable of producing a useful, concrete and tangible result when used in the computer system.

Claims 21-24 are rejected under 35 U.S.C. 101 for fully incorporating the deficiencies of their base claim.

9. Claim 25 is drawn to non-statutory subject matter because it fails to produce a tangible result. In order to be statutory, the claim must produce a useful, concrete, and tangible result. Specifically, marking nodes with a common mark specific to a target area does not necessarily produce a tangible result unless the structure of the input tree is saved, stored, or displayed. The mere marking of a data structure fails to produce a tangible result.

Furthermore, it is noted that claim 25 recites a computer program product including a computer readable medium. The claim recites functional descriptive material on a data processor-readable recording medium that can be a carrier wave

(Specification, page 15). The computer readable medium must be physical structure which provides the functional descriptive material in usable form to permit the functionality to be realized with the computer. A program product which does not explicitly include such a medium, a program per se, a signal or other type of transmission media that fails to include the hardware necessary to realize the functionality (e.g., a carrier wave) are all examples of media which are not believed to enable the functionality to be realized with the computer.

10. Claim 26 is drawn to non-statutory subject matter because it fails to produce a tangible result. In order to be statutory, the claim must produce a useful, concrete, and tangible result. Specifically, generating the tree fragment from the nodes marked with a common mark does not produce a tangible result unless the tree fragment is saved, stored, or displayed. The mere generating of a data structure fails to produce a tangible result.

Furthermore, it is noted that claim 26 recites a computer program product including a computer readable medium. The claim recites functional descriptive material on a data processor-readable recording medium that can be a carrier wave (Specification, page 15). The computer readable medium must be physical structure which provides the functional descriptive material in usable form to permit the functionality to be realized with the computer. A program product which does not explicitly include such a medium, a program per se, a signal or other type of

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transmission media that fails to include the hardware necessary to realize the functionality (e.g., a carrier wave) are all examples of media which are not believed to enable the functionality to be realized with the computer.

### ***Claim Objections***

11. Regarding claims 7, 19, and 26, it is noted a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Applicant is requested to amend claims to recite certain limitations currently in the preamble into the body of the claim.

### ***Allowable Subject Matter***

12. It is noted that claims 1-3, 5-7, 9-15, 17-19, and 21-26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and claim objections, set forth in this Office action.



***Response to Arguments***

13. Applicant's arguments with respect to art rejections regarding claims 1-3, 5-7, 9-15, 17-19, and 21-26 have been considered and are convincing. However, Examiner has presented rejections under 35 U.S.C. 101 regarding non-statutory subject matter.

It is noted that claims 1-3, 5-7, 9-15, 17-19, and 21-26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and claim objections, set forth in this Office action.

In view of the comments above, the rejection is maintained.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachna Singh whose telephone number is 571-272-4099. The examiner can normally be reached on M-F (8:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RS

08/23/06

  
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